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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,004	01/17/2002	Anthony C. Zuppero	22122878-10	9133

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EXAMINER	
DIAMOND, ALAN D	

ART UNIT	PAPER NUMBER
1753	

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/052,004	ZUPPERO ET AL.	
	Examiner	Art Unit	
	Alan Diamond	1753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 November 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,27-37 and 42-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,27-37 and 42-49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. 02022006
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Comments

1. The 35 USC 112, first paragraph, rejections of claims 1-8, 27-37, and 42-48 have been overcome by Applicant's amendment and arguments. In particular, the term "kinetic" has been changed to "vibrational", and, it is the Examiner's position that Applicant has pointed to the specification for adequate support for the term "at least some" with respect to the products of the chemical reaction and with respect to the vibrational energy transferred.

2. The 35 USC 112, second paragraph, rejections of claims 3, 27, 47, and 48 have been overcome by Applicant's amendment of the claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 49 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 49, at line 8, the "kinetic energy" is not supported by the specification, as originally filed. It is suggested that "kinetic" at line 8 be changed to "vibrational".

In claim 49, at lines 11-12, the recitation "with efficiency greater than 2% of catalytic reaction energy" is not supported by the specification, as originally filed.

Applicants argues that they have amended the term "kinetic" with vibrational". However, this argument is not deemed to be persuasive because such an amendment has not been done in claim 49.

With respect to the term "with efficiency greater than 2% of catalytic reaction energy" in claim 49, Applicant argues that the specification, on page 22, lines 1-2, describes that "the efficiencies well in excess of 50% can be achieved", and argues that 50% is greater than 2%. However, this argument is not deemed to be persuasive because the range of "well in excess of 50%" is not sufficient support for using 2% as a lower limit.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-8, 27-37, and 42-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S.

Patent No. 6,114,620. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of generating electricity in the claims of said patent inherently carries out the instant method for generating electrical energy and electromagnetic radiation.

7. Claims 1-8, 27-37, and 42-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,218,608. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of generating electromagnetic energy in the claim of said patent inherently carries out the instant method for generating electrical energy and electromagnetic radiation.

8. Claims 1-8, 27-37, and 42-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27-74 of U.S. Patent No. 6,268,560. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of generating electricity in the claims of said patent inherently carries out the instant method for generating electrical energy and electromagnetic radiation.

9. Claims 1-8, 27-37, and 42-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,327,859. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of moving an object in the claims of said patent inherently carries out the instant method for generating electrical energy and electromagnetic radiation.

10. Claims 1-8, 27-37, and 42-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,649,823. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of extracting energy in the claims of said patent inherently carries out the instant method for generating electrical energy and electromagnetic radiation.

11. Claims 1-8, 27-37, and 42-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,678,305. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of stimulating emission of radiation in the claims of said patent inherently carries out the instant method for generating electrical energy and electromagnetic radiation.

12. Claims 1-8, 27-37, and 42-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,700,056. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of generating energy in the claims of said patent inherently carries out the instant method for generating electrical energy and electromagnetic radiation.

13. Claims 1-8, 27-37, and 42-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 65-97, 102-130, and 144-156 of U.S. Patent No. 6,916,451. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of

converting adsorbate reaction energy into power, and the method of stimulating reactions in the claims of said patent inherently carries out the instant method for generating electrical energy and electromagnetic radiation.

14. Claims 1-8, 27-37, and 42-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-19 and 47 of copending Application No. 09/682,363. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of generating energy in the claims of said copending application inherently carries out the instant method for generating electrical energy and electromagnetic radiation.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 1-8, 27-37, and 42-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-25 and 27-33 of copending Application No. 10/185,086. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of energizing a quantum well in the claims of said copending application inherently carries out the instant method for generating electrical energy and electromagnetic radiation.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claims 1-8, 27-37, and 42-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32, 34, 35, 39, 40, 43, 44, 46, 48, 52-54, 57-63, 65, 67-72, 74-77, 79, 81-89, and 93-102 of copending Application No. 10/625,801. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of producing electrical energy in the claims of said copending application inherently carries out the instant method for generating electrical energy and electromagnetic radiation.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Claims 1-8, 27-37, and 42-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 and 32-35 of copending Application No. 10/759,341. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of forming an energy converter in the claims of said copending application inherently carries out the instant method for generating electrical energy and electromagnetic radiation.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

18. Claims 1-8, 27-37, and 42-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 11/084,425. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method for

creating hot atoms as a source of energetic free radicals on a catalyst surface in the claims of said copending application inherently carries out the instant method for generating electrical energy and electromagnetic radiation.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

19. Applicant's arguments filed November 28, 2005 have been fully considered but they are not persuasive.

Applicants argue that they will file a terminal disclaimer so as to overcome the obviousness-type double patenting rejections when the double patenting rejections are the only remaining issues in the case. However, this argument is not deemed to be persuasive because the double patenting rejections are not the only remaining issues, and no terminal disclaimer has been received.

Applicants request that the Examiner withdraw the provisional obviousness-type double patenting rejections when they are the only remaining issues in the case. However, this argument is not deemed to be persuasive because the provisional obviousness-type double patenting rejections are not the only rejections remaining in the case, and whether or not they can be withdrawn depends on the relative filing dates of the applications.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,944,202 is hereby made of record.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Diamond whose telephone number is 571-272-1338. The examiner can normally be reached on Monday through Friday, 5:30 a.m. to 2:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on 571-272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alan Diamond
Primary Examiner
Art Unit 1753

Alan Diamond
February 2, 2006